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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,991	03/31/2005	Ernest R Fernandez	7728-76964-02	5330
24197 7590 06/11/2007 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			EXAMINER DANG, HUNG XUAN	
			ART UNIT 2873	PAPER NUMBER
			MAIL DATE 06/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/529,991

Applicant(s)

FERNANDEZ ET AL.

Examiner

Hung X. Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 2 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. The amendment filed on 4/25/07 has been entered.
2. The indicated allowability of claims 1-11 is withdrawn in view of the newly discovered reference(s) to **Nishyama** (5,093,940). Rejections based on the newly cited reference(s) follow.

### Claims Rejection Under 35 USC – 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nishyama** (5,093,940).

Nishyama discloses exchangeable goggle comprises adapter ring 12 for mounting a lens 11 in wrap-type eyewear, said adapter ring 12 being mountable to the eyewear 20 and comprising: a rear portion having a first curvature that generally matches the curvature of the wrap type eyewear, said rear portion comprising a mounting means for maintaining said adapter ring to said eyewear; and a front portion comprising a lens mounting means for mounting a lens 11 onto the adapter ring, said lens mounting means having a second curvature that is less than said first curvature.

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Nishyama does not teach the lens is prescription lens as that claimed by Applicant.

Eyeglasses lenses have long been designed with the general objective of correcting the vision of the wearer. Therefore it would have been obvious to one skilled in the art to make the lens, of the Nishyama, prescription lens for the purpose of providing correcting vision of the wearer.

#### **Claims Rejection Under 35 USC - 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Chao** (5,631,716).

Chao discloses sports goggles having prescription lense comprises a frame 11 having a lens mounting means 13 therein; a prescription adapter ring 40 removably mounted in said lens mounting means 13, said adapter ring 40 comprising a prescription lens 30 therein; wherein said mounting means 13 has a higher wrap than said prescription lens (see at least figures 1-4 and the related disclosure.)

### **Claims Rejection Under 35 USC – 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Teng** (6,848,786).

Teng discloses sports goggles having prescription lense comprises a frame 1 having a lens mounting means therein; an adapter ring 2 removably mounted in said lens mounting means, said adapter ring 40 comprising a lens 22 therein; wherein said mounting means has a higher wrap than said lens (see at least figures 1-3 and the related disclosure.)

Teng does not teach the lens is prescription lens as that claimed by Applicant.

Eyeglasses lenses have long been designed with the general objective of correcting the vision of the wearer. Therefore it would have been obvious to one skilled in the art to make the lens, of the Teng, prescription lens for the purpose of providing correcting vision of the wearer.

### **Allowable Subject Matter**

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6. Claims 2 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

6/07

A handwritten signature in black ink, appearing to read 'Hung Dang', is written over the printed name.

HUNG DANG

PRIMARY EXAMINER

TC 2800